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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/836,012	04/17/2001	Jeffrey R. Sampson	10992153-1 (2003309-0013)	6991
22878	7590	11/08/2005	EXAMINER	
AGILENT TECHNOLOGIES, INC. INTELLECTUAL PROPERTY ADMINISTRATION, LEGAL DEPT. P.O. BOX 7599 M/S DL429 LOVELAND, CO 80537-0599			CHUNDURU, SURYAPRABHA	
			ART UNIT	PAPER NUMBER
			1637	

DATE MAILED: 11/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/836,012	Applicant(s) SAMPSON ET AL.	
	Examiner Suryaprabha Chunduru	Art Unit 1637	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 October 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: none.
 Claim(s) objected to: none.
 Claim(s) rejected: 1-17, 74-83.
 Claim(s) withdrawn from consideration: none.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☐ Other: _____.


JEFFREY FREDMAN
PRIMARY EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because: Applicants' arguments are found unpersuasive. With regard to the rejection under 35 USC 103(a) as being obvious over Southern et al. in view of Sorge, Applicants' argue that the combination does not teach or suggest the instant claims. Applicants argue that although Southern et al. teach mixtures of X-mers with characteristic sub-mixtures, Southern does not teach or suggest set of sub-mixtures having this characteristic in general as claimed in the independent claims and as disclosed in the instant specification at page 29, lines 1-5 for sub-mixture characteristics and argue that the combination of Southern in view of Sorge does not render the instant claims obvious. Applicants' arguments are fully considered and found unpersuasive. Applicants' agree that Southern et al. does teach the sub-mixtures having said characteristics as recited in the instant specification, thus it is inherent that the mixture taught by Southern et al. does have said characteristic in general and it is obvious that the combination does teach or suggest the instant claims. Applicants' further argue that Southern does not teach a single tag with a discrete molecular weight, that are distinguishable by mass spectrometry and Sorge does not remedy the deficiency of Southern et al. reference. In addition, Applicants argue that Sorge et al. teach colors of blocks or other tags that are in multiples of four and does not teach tags having discrete molecular mass and argue that the tags of the instant claims are not limited to those that simply "trace the alteration in size or molecular weight". Applicants' arguments are fully considered and found unpersuasive because the tags with different molecular mass taught by Sorge does read on the tags with discrete molecular weight as claimed in the instant claims and it is obvious that the combination of Southern et al. in view of Sorge does render the instant claims obvious as discussed in the previous office action. Therefore the rejection is maintained.

With regard to the rejection under 35 USC 103(a) as being obvious over Brenner in view of Sorge, Applicants argue that the X-mers and the oligonucleotide tags are not one and the same and the claims need to be interpreted in the light of the specification. Applicants argue that Brenner teach oligonucleotide tags and the a mixture of the same and does not teach the X-mers and tags as claimed in the instant claims and Sorge does not cure the deficiencies of Brenner. Applicants arguments are fully considered and found unpersuasive. Examiner agrees that claims are to be interpreted in the light of the specification, however, the claim limitations are broader in scope than that recited in the specification, thus the oligonucleotides and the mixture of the same taught by Brenner does teach the mixture of X-mer precursors (oligonucleotides) and tags (oligonucleotides) as recited in the instant claims and the combination of Sorge does make the instant claims obvious as discussed in the previous office action. Therefore the rejection is maintained.